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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bacardi & Company Limited

Serial No. 74/532,347

William R. Golden, Jr., Kelley, Drye & Warren for applicant.

David C. Reihner, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Sams, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Bacardi & Company Limited has filed a trademark
application to register the mark, LITTLE HAVANA¹ for "rum
and rum specialty drinks."

The Trademark Examining Attorney has finally refused
registration under Section 2(e)(3) of the Trademark Act, 15
U.S.C. 1052(e)(3),² on the ground that applicant's mark is

¹ Serial No. 74/532,347, in International Class 33, filed June 2, 1994,
based on a bona fide intention to use the mark in commerce.

² The amendments to Section 2 of the Trademark Act of 1946 made by
Public Law 103-183, 107 Stat. 2057, The North American Free Trade

primarily geographically deceptively misdescriptive in connection with its proposed goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

In order for registration to be properly refused under Section 2(e)(3), it is necessary to show that (i) the mark sought to be registered is the name of a place known generally to the public; and that (ii) purchasers are likely to believe, mistakenly, that the goods or services sold under applicant's mark have their origin in or are somehow connected with the geographic place named in the mark. *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982). See also, *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988), citing *In re Societa Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

Mark Conveys Primarily Geographic Connotation

With regard to the first prong of the test, we find that the primary significance of LITTLE HAVANA is

Enactment Act, apply to applications filed on or after December 8, 1993. Prior to these amendments, the prohibitions against registration on the grounds that a mark is primarily geographically descriptive or that a mark is primarily geographically deceptively misdescriptive were contained in Section 2(e)(2) of the Act. Under the law as amended, the prohibition against registration on the ground that a mark is primarily geographically deceptively misdescriptive is contained in Section 2(e)(3) of the Act, which is applicable to the case herein. The legal standard for determining this issue has not changed, although marks found to be primarily geographically deceptively misdescriptive are no

geographical. There is no dispute that LITTLE HAVANA is a well-known Hispanic community, substantially populated with émigrés from Cuba and Cuban-Americans, which is neither remote nor obscure, and which is located in Miami, Florida. The Examining Attorney submitted excerpts from seven articles contained in the NEXIS database to establish the geographic significance of LITTLE HAVANA.³

Additionally, the Examining Attorney contends that, as HAVANA is a principal city in Cuba, LITTLE HAVANA also connotes Havana, Cuba. The Examining Attorney states in his brief (p. 8) "[t]he addition of the word 'Little' qualifies the word so that it may refer to either a part of a section of the city of Havana, Cuba, or the section of the city of Miami, Florida, known as 'Little Havana.'" We agree that the record supports the conclusion that the term HAVANA is primarily geographic and connotes the city of Havana, Cuba. However, the record contains no evidence establishing either that there is a section of Havana, Cuba, referred to as LITTLE HAVANA, or that the relevant public in the United States would understand the phrase LITTLE HAVANA to refer to Havana, Cuba. Thus, we conclude that LITTLE HAVANA has a geographical connotation distinctly different from HAVANA,

longer eligible for registration under the provisions of Section 2(f) of the Act, subject to certain grandfather provisions.

³ The NEXIS search report submitted by the Examining Attorney indicates that he searched the database for LITTLE HAVANA within four words of MIAMI and found 1,582 stories. We presume that the seven stories in the record are a representative sample.

the former referring to the community in Miami, Florida, and the latter referring to the city in Cuba.

We are not persuaded that LITTLE HAVANA is not primarily geographic in connotation by applicant's contentions that HAVANA "evokes the image of a pre-Castro, free-wheeling lifestyle that would appeal to the purchasers of aged, fine rum"; or that applicant is "internationally renowned for being the originator of the light style of Cuban rum, aged and carefully blended, which became a favorite in the United States after Prohibition and continues to gain in popularity today." (Applicant's brief, p. 3.) See, *In re Bacardi & Company Limited*, ___ USPQ2d ___ (TTAB, Serial No. 74/534,987 *et.al.*, May 27, 1997). Applicant has submitted absolutely no evidence to establish on this record that the relevant purchasers would make such an association with the term HAVANA or that such an association would extend to the composite mark LITTLE HAVANA.⁴

Goods/Place Association

There is strong evidence in this case that Havana, Cuba, is a geographic location for which rum is a significant product so that consumers are likely to make a

⁴ Even if applicant had established an association between HAVANA and a particular lifestyle, such association would not contradict the primary geographic significance of HAVANA, as the association may be made precisely because of the primary significance of HAVANA as a city in Cuba.

goods/place association between HAVANA and rum products.⁵ Thus, if the primary geographic connotation of applicant's mark was Havana, Cuba, we would conclude that a goods/place association has been established and, thus, purchasers are likely to believe that rum products sold under such a mark originate in Havana, Cuba. However, that is not the case herein and we conclude that the Examining Attorney has not established a goods/place association between LITTLE HAVANA in Miami, Florida, and rum products.

In this regard, the Examining Attorney states (brief, p. 9):

How would people perceive the mark in relation to the goods if the mark refers to the Little Havana section of the city of Miami, Florida? Because applicant has no specific location from which its rum products originate, in that it is a diversified company; and applicant's goods are distributed in the United States from Miami, which includes the Little Havana section that is known for its Cuban-American and Cuban émigré community; and applicant uses the same formulae, ingredients, and know-how in producing its product as it developed in Havana, Cuba; purchasers would make an association between the location known as Little Havana, a part of Miami, and applicant's rum products. It may be believed that applicant's rum is either produced, bottled, processed, rebottled, stored, or aged in Little Havana, Miami. Purchasers would believe that Little Havana in Miami is one of the places of origin of the goods and be deceived because the goods are neither produced nor distributed through the Little Havana section of Miami.

⁵ The Examining Attorney has submitted evidence from dictionaries, encyclopedias and gazetteers indicating that Havana, Cuba, is a major city which produces a variety of goods, among which "rum" is listed as a significant product. Further, applicant has alleged that its family name, Bacardi, is widely associated with rum that is historically from Cuba and that U.S. consumers associate a certain popular style of rum as originating in Cuba.

We find the Examining Attorney's contention to be primarily conjecture. First, it does not automatically follow that, because rum is a product closely associated with Cuba, the same association extends to LITTLE HAVANA simply because it is substantially a Cuban-American/Cuban émigré community. The record does not establish such an association on this basis, nor does it establish any basis for concluding, regardless of any connection in the minds of purchasers between Cuba and LITTLE HAVANA, that purchasers would associate rum products with LITTLE HAVANA in Miami, Florida. Likewise, the fact that applicant's product was developed and originally produced in Cuba does not establish an association between rum products and LITTLE HAVANA.

It is a general principle that, absent a genuine issue that the term is remote or obscure, or that its primary significance is other than geographic, a goods/place association may be presumed from the fact that applicant's goods come from the place named in the mark. See, *In re California Pizza Kitchen, Inc.*, *supra* at 1706, citing *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982). In the case before us, applicant admits that its goods are manufactured in several specified countries outside the United States, other than Cuba, and that its goods enter the United States through Miami, where applicant's importer and

national distributor is located, but not the LITTLE HAVANA section thereof. Thus, we cannot presume that a goods/place association exists herein based on a conclusion that the goods originate in the place named in the mark, since applicant's goods do not originate in LITTLE HAVANA.⁶

Because we conclude that the Examining Attorney has not established a goods/place association between LITTLE HAVANA and the rum products identified in this application, we find that the Examining Attorney has not established that the mark herein is primarily geographically deceptively misdescriptive in connection with the identified goods under Section 2(e)(3) of the Act.

Applicant's Allegation of Extenuating Circumstances

While we have concluded that the Examining Attorney has not established that the mark herein is primarily geographically deceptively misdescriptive and, thus, the refusal to register is reversed, we feel compelled to address several of applicant's arguments which are not well-taken so that there is no misunderstanding about the basis for our decision herein.

In particular, applicant's contention, essentially, that extenuating circumstances warrant reversal of the refusal to register forms no basis for our reversal herein.

⁶ We disagree with the Examining Attorney's conclusion that applicant's goods originate in Miami. The fact that applicant's goods are manufactured in more than one location does not, alone, lead us to

Applicant states that it began its rum-producing business in Cuba and intends to resume producing rum in Cuba, and to use the proposed marks herein in connection with such rum, as soon as legally and politically possible. Applicant explains its history and relationship to Cuba, stating that "applicant is presently owned by descendants of Don Facundo Bacardi, who over a century ago in Cuba originated a recipe and process for the distillation and manufacture of rum that is sold under the BACARDI name and mark" and that "[o]n October 14, 1960, the Cuban properties of applicant's predecessor were unlawfully expropriated"; that applicant is a well-known producer of Cuban rum, which is now produced elsewhere according to the same formulae and processes that have been handed down over the past 130 years in the Bacardi family; that applicant originated the "light style of rum, aged and carefully blended" that applicant alleges is popular in the United States; and that applicant intends to produce rum in Cuba, where applicant's rum business began, "[w]hen the President of the United States, pursuant to the Cuban Democracy Act of 1992, 22 U.S.C.A. Section 6007(b), certifies that a democratic government has been re-established in Cuba such that the U.S. trade embargo with Cuba is lifted". Applicant submitted no evidence in support of its statements.

conclude that the mere importation and distribution of applicant's goods determines the place of origin of applicant's goods.

Applicant states, in its brief, that:

to refuse to allow intent-to-use applications . . . because of the current embargo, unfairly prejudices companies . . . that adhere to U.S. law. Cuban state-run trading companies, many of which operate out of facilities confiscated by Castro from pre-Castro Cuban free enterprises, are unfairly favored, because they are presumably permitted to register such marks in the United States on an 'intent-to-use' basis or under treaty rights even though they cannot have a present *bona fide* intent to use those marks in interstate commerce within the United States as the embargo does not permit such usage. Such a policy unfairly favors the anti-democratic, Communist-controlled business entities in Cuba, by permitting them, in effect, to register marks that arguably evoke the rich heritage of Cuban history and culture, while denying the expatriate Cuban businesses that helped build that heritage from registering marks . . . that evoke a pre-Castro, Cuban lifestyle. Such a policy is contrary to the Cuban Democracy Act, which is intended to promote the adoption of a democratic government in Cuba.

Applicant asserts that "[i]n view of recent events, it is quite possible that the policy of the U.S. government as expressed in federal law will be effective and within [the] thirty months [that an intent-to-use applicant is permitted after allowance in which to use a mark] democracy will be re-established in Cuba" and, thus, the Examining Attorney's refusal to register would be moot.⁷

We find applicant's position to be unpersuasive as it is based on a number of misconceptions. First and foremost,

⁷ As applicant notes, the provisions establishing and defining the terms of the trade sanctions, or "embargo," against Cuba can be found in the Trading With The Enemy Act, 50 U.S.C.A. App. § 16(b)(1), the Cuban Democracy Act, 22 U.S.C.A. 6001 *et. seq.* and the Cuban Asset Control Regulations, Chapter 31 C.F.R. Part 515.

we have found the primary geographic connotation of applicant's mark to be LITTLE HAVANA in Miami, Florida, rather than Havana, Cuba. Thus, the issues surrounding applicant's ability or inability to manufacture its goods in Cuba, and the existence of trade sanctions against Cuba, are irrelevant to our consideration in this case.

Similarly, we see no basis for applicant's allegations of prejudice. A so-called Cuban state-run trading company applying to register in the United States the marks herein on the basis of a *bona fide* intention to use such marks in commerce, in connection with the identified goods herein, would be subject to the same examination and same refusals to register as applicant. The fact that such company would likely indicate its intention for its identified goods to originate in HAVANA, Cuba, would result in the refusal, based on the geographic significance of the marks, being made under Section 2(e)(2), rather than, as herein, under Section 2(e)(3). Presumably, the sanctions contained in the relevant laws and regulations pertaining to Cuba would present the same problems to any intent-to-use applicant (*i.e.*, the uncertainty that the required use of the mark in commerce between the United States and Cuba could occur within the timeframe mandated in the Trademark Act so that the intent-to-use application could mature into a registration).

The Cuban Asset Control Regulations ("the Regulations"), at 31 C.F.R. 515.527, permit certain transactions with respect to the filing of trademark applications and maintenance of trademark registrations. Certain special procedures pertaining to such transactions are detailed in the Regulations; however, in all other respects, the procedural and substantive provisions of the Trademark Act and relevant law and regulations must be met.⁸

Finally, we note that, to the extent applicant is arguing that substantive examination of an application should be deferred until a statement of use is filed, applicant's position is not well-taken. While it is not the case herein, even if an uncertain future event could render a substantive refusal moot, the Examining Attorney is required to conduct, to the fullest extent possible, a substantive examination of an application, regardless of whether it is based upon Sections 1(a), 1(b) or 44 of the Act, prior to passing the application to publication for opposition. *See, In re Parfums Schiaparelli Inc.*, 37 USPQ2d 1864 (TTAB 1995); and *In re American Psychological Association*, 39 USPQ2d 1467 (Comm'r. 1996). Thus, the

⁸ Thus, for example, the most likely statutory basis for filing a trademark application, subject to the Regulations, would be under Section 44 of the Act, based on a foreign filing or registration in a country that is a party to the Paris Convention and/or the World Trade Organization. Further, an existing registration, which is subject to the Regulations, would be subject to the maintenance provisions in Sections 8 and 9 of the Act, permitting a showing of nonuse due to special circumstances.

Examining Attorney properly considered the issue of geographic descriptiveness during his examination of the subject applications. Further, applicant admitted that, at the time of filing the applications and during the examination thereof, it was legally precluded from producing the identified products in Cuba. Therefore, the Examining Attorney properly considered those facts, rather than considering applicant's allegations of possible future occurrences and, while reversed by this Board, his refusal under Section 2(e)(3) of the Act, on the ground that the marks herein are primarily geographically deceptively misdescriptive in connection with the identified goods was timely.

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Decision: The refusal under Section 2(e)(3) of the Act is reversed.

J. D. Sams

T. J. Quinn

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board